

REMARKS

By the above amendment, the abstract, which stands objected, has been amended to avoid the terms noted by the Examiner.

The rejection of claims 1, 6 and 7 under 35 USC 103(a) as being unpatentable over Kumar (US 6,591,758) is traversed and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature

which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In setting forth the rejection based upon Kumar, the Examiner recognizes differences between the claimed invention and the disclosure of Kumar. More particularly, the Examiner states:

However, Kumar does not distinctly state that an energy management processor is installed on each car. It would have been an obvious multiplication of parts to one of ordinary skill in the art to have installed the processor to each power car so that each car can be monitored separately and therefore not overload a single processor. Also, the addition of processors would allow for more efficient control of the power on each car as opposed to a single processor and would allow for the additional processors to backup the single processor in the event of a malfunction. (emphasis added)

Applicants submit that the Examiner's position is a hindsight reconstruction of the present invention utilizing what applicant has taught against the teacher. As noted in the decision of In re Fine, supra "obvious to try" is not the standard of 35 USC 103 and as indicated in the decision of In re Lee, supra it is not proper to utilize what the inventor has taught against the teacher.

Applicants note that claim 1 recites the feature of "a power management means for controlling the power generated by said power generation means and a storage quantity of said power storage means so as to minimize the power capacity of said power generation means, said power generation means being disposed in

every car so as to control each said power generation means and said power storage means independently". (emphasis added). Applicants note claim 1 further defines the railway car drive system as including a first railway car, a second railway car and a third railway car mounting specific structural members including power generation means, power converters, power storage means, as recited in claim 1, and applicants submit that Kumar does not disclose in the sense of 35 USC 103, the recited features of claim 1 and its dependent claims.

Irrespective of the contentions by the Examiner, applicants submit that the Examiner's indication that the driving motors use power from the generation means 102, 302 of each car to operate the respective driving motors is a recognition that the power generation means 102 operates the driving motors 108 of its car while the power generation means 302 operates the driving motors of its car, as is confirmed by the description in column 8, lines 24 - 48 of Kumar. Thus, applicants submit that Kumar does not disclose a second railway car mounting a power converter and a driving motor using the power generation means (of the first railway car) as a power source. That is, the second engine vehicle 301 of Kumar comprises a diesel engine 302 which drives the alternator/rectifier 304, one or more inverters 306 and a plurality of breaking grids 310 of the middle vehicle, as shown in Fig. 3 of Kumar, and described at column 8, lines 26 - 33 of Kumar. Thus, applicants submit that Kumar does not disclose the structural arrangement as recited in claim 1 and the Examiner's contentions with regard thereto represent a hindsight reconstruction attempt which is not disclosed or taught by Kumar.

Furthermore, irrespective of the Examiner's contention that an energy storage means is mountable on a separate third rail car, again, applicants submit that the Examiner is utilizing what applicant has taught against the teacher. As such,

applicants submit that the recited features of claim 1 are not disclosed or taught by Kumar in the sense of 35 USC 103 and should be considered allowable thereover.

Turning to the Examiner's contention that "It would have been an obvious multiplication of parts", applicants submit that the question is not whether the Examiner can reconstruct the claimed invention, but whether there is a disclosure or teaching in Kumar to provide such structural arrangement. Irrespective of the Examiner's contentions that it would have been obvious to one of ordinary skill in the art to have installed a processor to each power car so that each car can be monitored separately and therefor not overload a single processor and to provide more efficient control of the power on each car, such disclosure and teaching is not found in Kumar. In fact, applicants submit that while Kumar in column 6, lines 32 - 49, as pointed out by the Examiner, provides different possibilities regarding structural features in individual rail cars, Kumar provides no disclosure or teaching regarding the provision of an energy management processor installed on each car, as recognized by the Examiner, nor that such processor controls each power generation means and power storage means independently, as recited in claim 1 and the dependent claims. Thus, it is apparent that the Examiner has engaged in a hindsight reconstruction to suggest that the features, as disclosed and claimed in claim 1 of this application, are rendered obvious utilizing what applicant has taught against the teacher and not what Kumar has taught. Thus, applicants submit that claim 1 and the dependent claims patentably distinguish over Kumar in the sense of 35 USC 103 and should be considered allowable thereover.


In view of the above amendments and remarks, applicants submit that the abstract should be considered in compliance with the requirements therefor and claims 1, 6 and 7 patentably distinguish over the cited art and should now be in

condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 648.43135X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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